

REMARKS

Summary of the Office Action

Claims 1-28 and 30-38 are pending in this application.

Claim 32 was objected to due to certain enumerated informalities.

Claim 11 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 11, 13-14, and 17-18 were rejected under 35 U.S.C. § 102(e) as being unpatentable in view of Watanabe U.S. Patent No. 4,887,161 ("Watanabe").

Claims 15, 16, 19, 22, and 34-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Watanabe in view of Freeman U.S. Patent No. 6,068,183 ("Freeman").

Claims 1 and 4-7 were rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe in view of Freeman and further in view of Etoh U.S. Patent No. 5,728,289 ("Etoh").

Claims 25-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Watanabe in view of Freeman and further in view of Hornback PCT WO 99/56463 ("Hornback").

Claims 20, 21, 23, and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Watanabe in view of Freeman and further in view of Rowland U.S. Patent No. 5,801,970 ("Rowland").

Claims 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Watanabe in view of Hornback.

Claims 2 and 3 were rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe in view of Freeman, Etoh, and Rowland.

Claims 8-10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe in view of Freeman, Etoh, and Hornback.

Claims 30-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman in view of Ray U.S. Patent No. 5,321,751.

Interview Summary and Reply to §§ 102 and 103 Rejections

On January 23, 2008, Examiner Tran and applicant's undersigned representative conducted a telephonic interview on the merits of the above-identified patent application. Applicant and applicant's representative wish to thank the Examiner for the courtesies extended during the interview.

Generally, the Examiner and applicant's representative discussed proposed amendments to the independent claims and addressed the rejections included in the Office Action mailed on August 3, 2007. More specifically, the Office Action stated that applicant's independent claims 1, 11, 19, 22, 30, 33, and 36 were rejected under 35 U.S.C. § 102(b) as being anticipated by Watanabe or under 35 U.S.C. § 103(a) as being unpatentable over Watanabe in view of one or more of Freeman, Etoh, and Ray. See Office Action, pages 5, 7, 11, and 20. At the conclusion of the interview, the Examiner acknowledged for the reasons discussed below that the claims, as amended, overcame the rejections raised in view of Watanabe, whether taken alone or in

combination with Freeman, Etoh, and Ray. Furthermore, as discussed with the Examiner, applicant added a new independent claim 39 with new dependent claims 40-45 that are also allowable over Watanabe, whether taken alone or in combination with Freeman, Etoh, and Ray. Applicant has canceled claims 10, 12, 15-16, and 28 without prejudice.

More specifically, applicant's independent claims 1, 11, 19, 22, 30, 33, and 36 recite apparatuses and methods of utilizing an apparatus that fits in a pocket-sized wallet and displays user-provided digital images. The independent claims have been amended to recite a connector component that couples the device to a user device. The claims also now require the user device to have its own, separate display, and the user-provided digital images to be downloaded from the user device.

Watanabe fails to show or suggest a user device that has its own, separate display. In contrast, Watanabe only suggests a single display device that is located on a memory cartridge (Watanabe, column 3, lines 26-28). Although the memory cartridge may be loaded into a digital still video camera, the camera does not show or suggest having its own, separate display (Watanabe, FIG. 2). Moreover, Watanabe also fails to show or suggest downloading user-provided images from the device that has its own, separate display.

Etoh, Freeman, and Ray fail to make up the deficiencies of Watanabe. Etoh is focused on an image pick-up device that provides "high operability" when a "large screen size monitor" is mounted on the image pick-up device (Etoh, abstract). Etoh, despite being filed 8 years after Watanabe, could clearly not fit in a pocket-sized wallet. Furthermore,

Etoh fails to show or suggest a connector component that couples the device to a user device, wherein the user device has its own separate display and from which user-provided digital images are downloaded.

Ray is directed to providing a secure credit card by verifying the authenticity of a credit card holder (Ray, abstract). As such, Ray is completely unrelated to portable electronic photo albums. Even if one looks past the fact that Ray is irrelevant, Ray teaches away from applicant's claimed invention and cannot be combined with Watanabe. If Ray could be combined with Watanabe, the result would either be a credit card on which any person could store, display, and change images and other data, or the result would be a secure memory cartridge that cannot receive user-provided data. The former would result in a credit card that loses all security and authenticity, which is contrary to the intended purpose of Ray of making credit cards more secure by verifying the authenticity of the credit card holder (Ray, abstract). The latter would result in a secure memory cartridge to which a user, or a user device, could not download images, which is contrary to the intended purpose of Watanabe's memory cartridge. [For at least this reason and because cited references must be considered in their entireties, i.e., as a whole, including portions that would lead away from the claimed invention, Ray teaches away from applicant's invention and teaches away from its combination with Watanabe. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).] Thus, the combination of Watanabe and Ray would result in

rendering both Ray's system and Watanabe's system inoperable. Moreover, applicant's claimed invention, as amended, recites the downloading of user-provided images from a user device having its own display, and this is not shown or suggested by the Watanabe-Ray combination.

By similar reasoning, Freeman teaches away from Watanabe and cannot be combined with Watanabe to show or suggest applicant's claimed invention of a device that fits in a pocket-sized wallet and displays user-provided digital images downloaded from another user device having its own, separate display. Freeman is directed to a chip card for displaying advertisement information (Freeman, abstract). The chip card is also used for storing monetary value (Freeman, column 1, line 20), delivering coupons (Freeman, column 1, line 57), and authorizing ticket admissions (Freeman, column 2, lines 6-7). Monetary value, coupons, and ticket authorizations need to be secure from the user and not user-provided. If monetary value, coupons, or tickets were user-provided, Freeman would be rendered useless. Thus, the combination of Watanabe and Freeman is not possible, and moreover still fails to show or suggest applicant's claimed invention.

In accordance with the agreement reached during the telephonic interview, applicant has incorporated into this Reply to Office Action the discussed claim amendments to independent claims 1, 11, 19, 22, 30, 33, and 36 as well as the above summary of the remarks applicant's representative made, and the Examiner found persuasive, during the telephonic interview. The claim amendments are fully supported and

justified by applicant's specification and drawings (see, for example, applicant's specification, page 12, lines 28-32 and FIG. 2).

In addition, applicant also wishes to include the following remarks, even though the Examiner indicated that he may not find them persuasive. First, none of the cited references show or suggest applicant's claimed invention in the most generic sense—i.e., an electronic photo album designed to fit in a pocket-sized wallet. Instead, Watanabe, Freeman, Etoh, and Ray are generally directed to, respectively, a memory cartridge designed to fit in a camera, a secure chip card, a camera, and a credit card.

Second, Watanabe is directed to a memory cartridge including a display device for displaying a digital image (see Watanabe, abstract). Moreover, Watanabe shows a forward-feed switch and a reverse-feed switch on the memory cartridge for feeding frames of images being displayed (see Watanabe, column 6, lines 31-34 and FIG. 5). Watanabe never gives dimensions for the memory cartridge, yet the Watanabe figures portray the memory cartridge as being less than a few millimeters in thickness (see, for example, FIG. 5). Furthermore, Watanabe says that the "memory cartridge can be used as a portrait placed on a desktop" (Watanabe, column 6, lines 13-15). A device as thin as the device shown by Watanabe could NOT physically act as a "portrait placed on a desktop".

Additionally, one must note that Watanabe was filed in 1988. Thus, without the Examiner providing a technical explanation of how Watanabe is enabled to provide its functionality in its illustrated form, one skilled in the art

would probably assume the following: it is more likely that the figures which portray the memory cartridge as being less than a few millimeters in width are a result of poor draftsmanship and are not drawn to scale, than it is likely that Watanabe would actually operate as illustrated. Moreover, although Watanabe suggests that the "memory cartridge can be used as . . . an ID card bearing the image of the possessor" (Watanabe, column 6, lines 13-15), one skilled in the art in 1988 would have been led to believe the ID card was large and non pocket sized. If one skilled in the art at the time of Watanabe furthermore wished to include forward-feed and reverse-feed switches, the resulting device would probably have been even larger in size.

The only reference to show a pocket-sized device that comprises a digital display is Freeman's chip card. However, as discussed above, Freeman still fails to show or suggest a pocket-sized device for displaying user-provided digital images. Not only are the items in the Freeman display not provided by a user, but they comprise only text and, at best, a small icon (Freeman, FIGS 1A and 1C). In short, Freeman does not show or suggest the ability to display user-provided digital images.

At least since Watanabe first suggested a memory cartridge having a display device for displaying digital images, there has been a long felt need for a pocket-sized digital photo album. However, this need was not met until applicant's claimed invention, and a person may overcome obviousness when the claimed invention satisfies a long felt

but unsolved need (MPEP § 2145 Consideration of Applicant's Rebuttal Arguments).

In conclusion, applicant respectfully submits that amended independent claims 1, 11, 19, 22, 30, 33, and 36 are allowable over Watanabe and the other documents of record at least in view of the interview conducted on January 23, 2008 and the above remarks. Claims 2-9, 13-14, 17-18, 20-21, 23-27, 31-32, 34-35, and 37-38 are allowable at least because they depend on an allowable independent claim. ("If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir 1988); MPEP § 2143.)

Applicant's Reply to the Claim Objection

The Examiner objected to claim 32 because of the recitation of "the memory card." Applicant has amended claim 32 to recite "a memory card" as the Examiner suggested.

Applicant's Reply to the 35 U.S.C. § 112 Rejection

The Examiner objected to claim 11 under 35 U.S.C. § 112 as being indefinite. In response, applicant has amended claim 11 to differentiate the first use of the phrase "one or more digital images" from the second use of this phrase by specifying "one or more user-provided digital images" in the first use of the phrase. Applicant submits claim 11, as amended, meets the requirements of 35 U.S.C. § 112 and therefore respectfully requests that this claim rejection be removed.

Applicant's New Claims

Applicant has added new independent claim 39 and new dependent claims 40-44. The new claims are fully supported and justified by applicant's originally-filed specification and drawings. No new subject matter has been added by the new claims. At least for the reasons discussed above, the new claims contain subject matter that is allowable over Watanabe, whether taken alone or in combination with Freeman, Etoh, and Ray.

Conclusion

Applicant respectfully submits that this application is in condition for allowance. Prompt consideration and allowance of this application are respectfully requested.

Respectfully submitted,



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